

REMARKS

I. Interview

Initially, Applicants thank Patent Examiner Marissa Thein and Supervisory Patent Examiner Alex Kalinowski for the courtesy of the telephone interview conducted on January 11, 2006. In the interview, Applicant's representative discussed examples in accordance with claimed embodiments and how limitations associated with those examples are recited in the pending claims (claims 67 and 68 in particular). The Examiners appeared to agree that the claims are patentable over the currently cited references and suggested certain minor language changes to the claims that may more clearly describe certain embodiments. Such language changes, as requested and/or suggested by the Examiners, are incorporated into the pending claims by this amendment.

II. Introduction

Claims 1-64 and 67-68 are currently pending in the present application. Claims 1, 55, 58-60, and 67-68 are independent. All pending claims stand rejected. In particular:

(A) claims 1, 55, 58-60, and 67-68 stand rejected under 35 U.S.C. §112, first paragraph, for allegedly failing to comply with the written description requirement;

(B) claims 1-64 and 67-68 stand rejected under 35 U.S.C. §101 for being allegedly directed to non-statutory subject matter; and

(C) claims 1-64 and 67-68 stand rejected under 35 U.S.C. §103(a) for allegedly being unpatentable over www.peapod.com (hereinafter "peapod") in view of U.S. Patent No. 5,566,327 (hereinafter "Sehr").

Upon entry of this amendment, which is respectfully requested, claims 1, 9, 17, 25, 28, 35, 41, 45, 49, 53-55, 58, 60, 62, and 67-68 will be amended for purposes of clarification and claims 2 and 18 will be cancelled without prejudice or disclaimer.

No new matter is believed to be introduced by this amendment, and Applicants believe that the subject matter of all pending claims has previously been searched by the Examiner.

Applicants hereby respectfully request reexamination and reconsideration of the pending claims in light of the remarks provided herein and in accordance with 37 C.F.R. §1.112.

III. The Examiner's Rejections

A. *Rejections under §112, first paragraph*

Claims 1, 55, 58-60, and 67-68 stand rejected under 35 U.S.C. §112, first paragraph for allegedly failing to comply with the written description requirement. Applicants traverse this ground for rejection as follows.

Applicants respectfully note that the limitation *wherein no buyer preference is indicated between the at least two products from each of the plurality of product categories* is supported and adequately described in the specification as filed, at least at:

Pg. 8, lines 17-25; pg. 9, lines 11-31; pg. 10, lines 3-20; pg. 11, lines 12-18; pg. 13, lines 26-30; pg. 15 to pg. 18, examples; pg. 24, lines 8-17; FIG. 7; and pg. 36, lines 29-32.

Applicants also respectfully note that the limitation *wherein the offer price may differ from an offer price defined by another buyer for the same first and second subsets of products* is supported and adequately described in the specification as filed, at least at:

Pg. 9, lines 11-31; pg. 11, lines 19-27; pg. 13, lines 22-25; pg. 15 to pg. 18, examples; pg. 24, lines 8-17; FIG. 7; FIG. 8; and description of FIG. 8, pg. 25 to pg. 27.

At least for these reasons, Applicants hereby respectfully request that the §112, first paragraph rejections of claims 1, 55, 58-60, and 67-68 be withdrawn.

B. *Rejections under §101*

The sole basis for rejecting claims 1-64 and 67-68 appears to be the Examiner's allegation that "the first test of whether an invention is eligible for a patent is to determine if the invention is within the 'technological arts'", Office Action, pg. 3, lines 5-6 from the bottom (emphasis added), and the Examiner's finding, that claims 1-64 and 67-68 "have no connection to the technological arts." *Id.*, pg. 6, lines 3-4.

As explained by the Board of Patent Appeals and Interferences (BPAI) in the recent precedential opinion of Ex parte Lundgren, the purported requirement that all steps must be performed *per se* by use of a computer or other apparatus *is not* a proper basis for

rejection. The Board expressly held that the alleged requirement that a claim must be “within the technological arts” has no legal basis:

Our determination is that **there is currently no judicially recognized separate "technological arts" test** to determine patent eligible subject matter under § 101. We decline to create one. Therefore, it is apparent that the examiner’s rejection can not be sustained.

Ex parte Lundgren, Appeal No. 2003-2088, 9 (BPAI Oct., 2005); emphasis added.

The examiner’s rejection under §101 in Lundgren was based solely on an alleged failure to suggest “computer, automated means, apparatus of any kind” and thus being “outside the technological arts.” Accordingly, the Board reversed the §101 rejection.

Every one of claims 1-64 and 67-68 produces a useful, concrete and tangible result. The Examiner relies on the same and only basis that was expressly rejected by the Board in Lundgren – an alleged failure to comply with a legally baseless requirement to recite a computer.

Applicants therefore respectfully request that the §101 rejections of claims 1-64 and 67-68 be withdrawn

C. Rejections under §103(a) – peapod in view of Sehr

Claims 1-64 and 67-68 stand rejected as being allegedly unpatentable over peapod in view of Sehr. Applicants respectfully traverse this ground for rejection as follows.

As discussed in the interview of January 11, 2006, neither peapod nor Sehr teach or suggest various limitations of the pending claims. In particular neither peapod nor Sehr teach or suggest (i) *receiving buyer offer information, including an indication of an offer amount associated with the plurality of product categories, wherein no buyer preference is indicated among the plurality of products in each of the plurality of categories*, or (ii) *selecting, by the controller, the first and second subsets of products, wherein the selecting is based at least in part on the buyer’s offer price* (limitations generally recited by all pending claims).

In other words, neither peapod nor Sehr teaches or suggests a method or system that allows a buyer to make an offer for a product from a category, where the particular

product to be purchased is selected or chosen by an entity other than the buyer (e.g., selected for the buyer by a controller).

Accordingly, Applicants respectfully request that the §103(a) rejections of claims 1-64 and 67-68 be withdrawn.

IV. Claim Amendments

Applicants note that the current amendments to the claims, as suggested by the Examiners in the telephone interview of January 11, 2005 are submitted solely for clarification and/or consistency purposes, and are not submitted to distinguish over the cited references. Applicants note, for example, that the use of the term “selecting” as opposed to the term “choosing” is merely semantic and is not believed to narrow the scope of any limitations, and otherwise simply improves the consistency of terminology amongst claims. It is also important to note that neither reference teaches or suggests *selecting, by the controller, the a product from a category of products* (e.g., for the buyer), where the buyer has submitted an offer for no particular product in the category, regardless of whether *the selecting is based at least in part on the buyer’s offer price* or not. In other words, the newly added limitation *wherein the selecting is based at least in part on the buyer’s offer price*, is not provided to overcome the current rejections in light of the cited references.

V. Conclusion

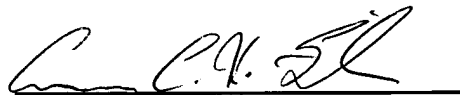
At least for the foregoing reasons, it is submitted that all pending claims are in condition for allowance and the Examiner's early re-examination and reconsideration are respectfully requested.

Alternatively, if there remain any questions regarding the present application or the cited reference, or if the Examiner has any further suggestions for expediting allowance of the present application, the Examiner is cordially requested to contact Carson C.K. Fincham at telephone number 203-461-7017 or via electronic mail at cfincham@walkerdigital.com, at the Examiner's convenience.

Respectfully submitted,

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Date



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